

PATENT



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OFFICE OF PETITIONS

Atty. File No. 17,634L USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re/

Application of
William Strausbaugh, Eric M. Boyer
and Richard P. Buterbaugh
Application No. 10/060,946
Filed January 30, 2002
Improved Method for Packaging Passive
Optoelectronic Assemblies in a Limited Space
Attorney Docket No. 17634L USA

Group No.: Not Assigned
Examiner: Not Assigned

CERTIFICATE OF EXPRESS MAIL

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on June 20, 2002 as "Express Mail Post Office to Addressee" service under 37 CFR 1.10, Express Mail Label No. EV122871801US in an envelope addressed to: Attn: Latrice Bond, Office of Petitions, Assistant Commissioner for Patents, Box DAC, Washington, DC 20231.

Date: June 20, 2002


Andrea C. Wright

Attn: Latrice Bond
Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

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PETITION UNDER 35 U.S.C. § 116
AND § 118 AND 37 C.F.R. § 1.47(a)

Dear Sir:

Applicant hereby submits a Petition for completing the requirements for filing the above-identified application under 35 U.S.C. § 111 and 37 C.F.R. § 1.63 with Declarations executed by

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inventors William Strausbaugh and Richard Buterbaugh on behalf of themselves and co-inventor Eric Boyer who refuses to and/or is unavailable to execute the Declaration and Assignment documents.

FACTS

Eric Boyer is a co-inventor named in the above-identified application and is party to an Intellectual Property Agreement (the "Agreement") with The Whitaker Corporation. A true and correct copy of the Agreement is attached hereto as Exhibit 1. Pursuant to the Agreement, Mr. Boyer has an obligation to assign to The Whitaker Corporation, and its successors in interest, any and all patent rights he may have in and to the above-identified patent application, and to execute and deliver all proper documents necessary and attendant to domestic and foreign patent applications of The Whitaker Corporation. See Agreement at Paragraph (4). As set forth below and in the attached Declaration, several attempts have been made to contact Mr. Boyer by telephone, and a request has been made of Mr. Boyer in the form of a letter to have him execute an Assignment of the above-identified application to The Whitaker Corporation pursuant to Paragraph (4) of the Agreement. All of the above attempts at contact have been unsuccessful.

On May 7, 2002, Mr. Boyer was sent an Assignment document to his last known address via overnight courier. The address is: 717 Claster Boulevard, Dauphin, Pennsylvania 17018. Attached as Exhibit 2 is a copy of our transmittal letter to Mr. Boyer. No response from Mr. Boyer has been received by The Whitaker Corporation.

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On May 14, May 15 and May 17, 2002, attempts were made by Paula Capriglione of The Whitaker Corporation to reach Mr. Boyer by telephone but he could not be reached as there was no answer and no voice mail. Attached as Exhibit 3 is a copy of a file Memorandum containing this information.

On June 19, 2002, an attempt was again made by Mary Bertolino, a paralegal with Synnestvedt & Lechner LLP, outside counsel for The Whitaker Corporation, to contact Mr. Boyer by telephone. A message was left on his answering machine, which was activated this time, and he was requested to return the call. A return phone call has not been received. Attached as Exhibit 4 is a copy of a file Memorandum containing this information.

PETITION

In view of the foregoing facts, Applicants request that the present Assignment be regarded as complete under 35 U.S.C. § 115 and 37 C.F.R. §§ 1.63 and 1.64 pursuant to 35 U.S.C. § 116 and § 118 and 37 C.F.R. § 1.47(a). Granting of this Petition is necessary to preserve the parties' rights and to prevent irreparable damage to Applicants, which would occur if the above-identified patent application were to be abandoned.

Please charge Deposit Account No. 19-5425 in the amount of \$130.00 to cover the cost of this Petition. Any deficiency or overpayment should be charged or credited to Deposit Account No. 19-5425. Two additional copies of this Petition are enclosed.

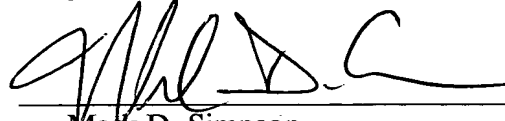
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PRAYER FOR RELIEF

Applicants and Applicants' assignee, The Whitaker Corporation, pray for grant of this petition. This action is necessary to preserve the rights of the parties and to prevent irreparable damage. Early and favorable action on this Petition is earnestly solicited.

Respectfully submitted,



Mark D. Simpson
Attorney for Applicants
Registration No. 32,942

Dated: June 20, 2002

:mdb

Enclosures

Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107
Telephone: (215) 923-4466
Facsimile: (215) 923-2189

INTELLECTUAL PROPERTY AGREEMENT

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It is recognized by the undersigned that by reason of being employed by AMP INCORPORATED (which together with any affiliated company is herein called "Company"), he or she may create or develop intellectual property (including inventions, ideas, discoveries, trade secrets and copyrightable works) resulting from or arising out of the work performed by the undersigned within the scope of his or her responsibilities, or with the Company's facilities, equipment or supplies, or resulting from his or her use or knowledge of confidential or trade secret information which is proprietary to the Company. In consideration of employment by the Company and of the special opportunities for advancement which may come from such creative work, the undersigned hereby acknowledges the sufficiency of said consideration and assumes, and will carry on his or her employment under the following continuing obligations:

- (1) During the period of said employment, the undersigned agrees to report to the Company fully and promptly in writing, all intellectual property (including inventions, ideas and discoveries, patentable or unpatentable, trade secrets and copyrightable works) which is made, developed, conceived or reduced to practice by the undersigned either solely or jointly with others resulting from or arising out of the work performed by the undersigned, within the scope of his or her responsibilities, or with the Company's facilities, equipment or supplies, or which results from his or her use or knowledge of confidential or trade secret information which is proprietary to the Company.
- (2) Upon termination of said employment, for a period of two (2) years after termination, the undersigned agrees to report to the Company fully and promptly in writing, all intellectual property (including inventions, ideas and discoveries, patentable or unpatentable, trade secrets and copyrightable works) which is made, developed or conceived by the undersigned either solely or jointly with others, whenever such intellectual property reasonably results from the work performed by the undersigned during employment by the Company within the scope of his or her responsibilities, or with the Company's facilities, equipment or supplies, or results from his or her use or knowledge of confidential or trade secret information which is proprietary to the Company.
- (3) The undersigned agrees to hold all such intellectual property as described in Paragraphs (1) and (2) above for the benefit of the Company and not to assign nor attempt to assign any rights therein to anyone else.
- (4) The undersigned agrees to assign to the Company upon its request and without further compensation all rights, title and interest in such intellectual property as described in Paragraphs (1) and (2) above at any time whether during or subsequent to his or her period of said employment. The undersigned agrees to execute and deliver in a prompt manner all proper documents provided by the Company and presented to the undersigned including those necessary and attendant to domestic and foreign patent applications including but not limited to divisional, continuation, continuation-in-part, substitute and/or reissue applications, and all other instruments for the perfection of intellectual property rights including related registrations of issued patents, design patent applications and registrations, applications for utility models and industrial models and copyrights, as well as formal assignments thereof.
- (5) The Company will pay reasonable out-of-pocket expenses incurred by the undersigned in perfecting the Company's rights as they relate to assisting the Company in all proper ways in the acquisition and preservation of the rights to such intellectual property as described in Paragraph (4) above.
- (6) All of the covenants and provisions herein contained are severable; in the event that any of said covenants or provisions shall be held by any court of competent jurisdiction to be invalid or unenforceable, this agreement shall be construed as if any such invalid or unenforceable covenant or provision were not herein contained.
- (7) The undersigned covenants that there are no unpatented inventions, discoveries, ideas or information to be withheld from operation of this agreement except items as listed on the reverse side of this sheet and there approved by an authorized representative of the Company.
- (8) This agreement is separate from and does not replace or alter the Confidentiality Agreement between the Company and the undersigned.

Intending to be legally bound, the undersigned has executed this agreement on the date indicated below.

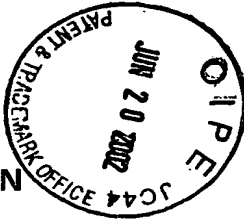
Signed Eric M. Bayer (Seal)

Name (printed) Eric M. Bayer

Date 6/29/98

Witness

Jodi R. Freedman



THE WHITAKER CORPORATION
4550 New Linden Hill Road
Suite 450
Wilmington, DE 19808

Stephen J. Driscoll
(302) 633-2743 / Fax: (302) 633-2776

VIA OVERNIGHT COURIER

May 7, 2002

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Eric Boyer
717 Claster Blvd.
Dauphin, PA 17018

Improved Method For Packaging Passive Optoelectronic Assemblies
In A Limited Space
Docket No. 17634

Dear Eric:

Attached is an assignment document for your signature for the above patent application. The specification and drawings are also attached for your review.

Please review this application and pay attention to not only the accuracy of its substance but also to three important duties you have as an applicant for a United States Patent; namely, the duties to name the true inventors, to disclose material information, and to disclose the best mode for practicing the invention.

To this end, review for accuracy that only actual inventors have been named. Please keep in mind that inventors may apply jointly for a patent even though:

- (1) They did not physically work together or at the same time;
- (2) Each inventor did not make the same type or amount of contribution; or
- (3) Each inventor did not make a contribution to the subject matter of every claim of the application.

Furthermore, there is a duty of candor required of each applicant. This duty is a duty to disclose information material to the patentability of the invention. Finally, it is required that the best mode contemplated by the inventor(s) in carrying out his/her invention as of the date of filing the application be set forth in the description of the invention.

After you have reviewed the specification and drawings, please sign the assignment on page 3 where indicated in the presence of two witnesses and have the witnesses sign as well. Also, please initial all unsigned pages of the assignment document.

Please return the documents back to me ASAP in the enclosed overnight envelope.

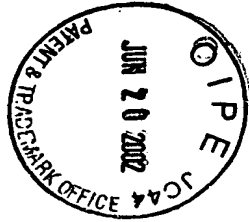
Thank you for all your cooperation and assistance; and if you have any questions, please call.

Sincerely,

A handwritten signature in cursive script that reads "Stephen J. Driscoll/pmc". The signature is written in dark ink and is positioned above the printed name and title.

Stephen J. Driscoll
Patent Attorney

SJD/pmc
Enclosure(s)



TO: MEMO TO FILE

FROM: Paula M. Capriglione

In an effort to file the NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION dated 03/20/2002, I have tried several times to contact inventor Eric Boyer for signature of the Assignment, and Declaration and Power of Attorney.

1. Contacted Eric Boyer by phone at 11:28 a.m. on 5/14/02 and got no answer.
2. Contacted Eric Boyer by phone at 3:34 p.m. on 5/14/02 and got no answer.
3. Contacted Eric Boyer by phone at 9:15 a.m. on 5/15/02 and got no answer.
4. Contacted Eric Boyer by phone at 8:30 a.m. on 5/17/02 and got no answer.

Memo



To: File
From: Mary D. Bertolino
Date: June 20, 2002
Subject: Execution of Combined Declaration and Power of Attorney
by Inventor, Eric M. Boyer
U.S. Appln. No. 10/060,946
Whitaker File No. 17634L USA
S&L File No. P24,754A USA

June 19, 2002:

At the request of Steve Driscoll, I called Mr. Boyer (717-921-0120) regarding the status of the executed Combined Declaration and Power of Attorney for the above-identified application. I left Mr. Boyer a message on his answering machine requesting that he return the call and advise when we may expect to receive the executed document.

June 20, 2002:

I have not received a return phone call from Mr. Boyer.



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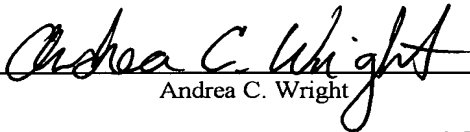
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Attorney Docket No. 17634L USA

Group No.: Not Assigned
Examiner: Not Assigned

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Date: June 20, 2002


Andrea C. Wright

Attn: Latrice Bond
Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

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DECLARATION UNDER 37 C.F.R. § 1.47(a) AND 35 U.S.C. § 116

Dear Sir:

I, Mark D. Simpson, am an attorney for the Applicants, have reviewed the file for the present application, have discussed the file contents with my partner, Stephen J. Driscoll, an

attorney of record in the present application, and Mary Bertolino, a paralegal from Synnestvedt & Lechner LLP working on this file, and have satisfied myself that upon information and belief, the following statements are true and accurate, and thus declare as follows:

1. Mr. Eric M. Boyer is one of the co-inventors named in the above-identified application and a party to an Intellectual Property Agreement (the "Agreement") with The Whitaker Corporation.

2. A true and correct copy of the Agreement is attached hereto as Exhibit 1.

3. Pursuant to the Agreement, Mr. Boyer has an obligation to assign to The Whitaker Corporation, and its successors in interest, any and all patent rights he may have in and to the above-identified patent application, and to execute and deliver all proper documents necessary and attendant to domestic and foreign patent applications of The Whitaker Corporation. See Agreement at Paragraph (4).

4. Several attempts have been made to contact Mr. Boyer by telephone, and a request has been made of Mr. Boyer in the form of a letter to execute an Assignment of the above-identified application to The Whitaker Corporation pursuant to Paragraph (4) of the Agreement.

5. On May 7, 2002, Mr. Boyer was sent an Assignment document to his last known address via overnight courier. No response from him has ever been received.

6. On May 14, May 15 and May 17, 2002, attempts were made to reach Mr. Boyer by telephone but there was no answer and no voice mail on which to leave a message.

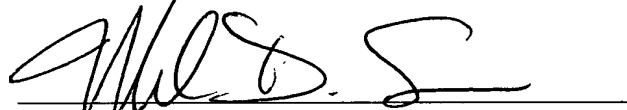
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7. On June 19, 2002, attempts were made to contact Mr. Boyer again by telephone. A message was left on his answering machine, which was activated this time, and a request was made that he return the call. No return phone call has ever been received.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this Declaration is directed.

Respectfully submitted,



Mark D. Simpson
Attorney for Applicants
Registration No. 32,942

Dated: June 20, 2002

MDS:mdb

Enclosures

Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107
Telephone: (215) 923-4466
Facsimile: (215) 923-2189